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*J.W.*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/366,549    08/04/99    HORIKAWA    J    SON-1648/CON

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EXAMINER

DO, A

ART UNIT

PAPER NUMBER

2724

*4*

DATE MAILED:

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/366,549

Applicant(s)

Horikawa et al.

Examiner

Anh Hong Do

Group Art Unit  
2724



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-136 is/are pending in the application.

Of the above, claim(s) 1-19 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 20-136 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Aug 4, 1999 is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Aug 4, 1999 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/755,129.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/755,129, filed on 11/25/96.

### *Drawings*

2. Figure 14 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 20-47 and 76-108 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 5,963,668.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to the same subject matter.

The claims in the instant application define the invention more precisely than the claims in the patent, however they are not patentably distinguishable from the claims in the patent. In re White et al., 160 USPQ 417, In re Thorington et al., 163 USPQ 644. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

For example, comparing representative claim 20 of the present application with representative claims 1 and 8 of Patent No.5,963,668:

Independent claim 20 of the application recites: A method of approximating an image by decreasing an amount of image data used to create the image, wherein said image data defines a polygonal framework, said framework being composed of line segments drawn between vertices, said method comprising: (Claim 8 of the Patent recites: *A method of approximating an image by selectively decreasing an amount of image data used to create the image, wherein said image data defines a polygonal framework on which textures or pictures are drawn, said framework being composed of line segments drawn between vertices, said method comprising:*); evaluating a degree of importance of each line segment of said framework (claim 8 of the Patent: *assigning an importance value to each line segment of said framework ...* and claim 1 of the Patent: *evaluating*

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*a degree of importance of each edge constructing said shape data*); removing at least one unnecessary line segment from said framework which is identified based on said evaluation of said degree of importance of each line segment (claim 8 of the patent: *removing from said framework that line segment having said lowest importance value* and claim 1 of the patent: *removing an unnecessary edge on the basis of a result of an evaluation of said edge*); determining a position of a vertex after said unnecessary line segment is removed (*claim 1 of the patent: determining a position of a vertex after said unnecessary edge was removed*).

Another example, comparing independent claim 76 of the present application with claims 1, 8 and 14 of Patent No. 5,963,668:

Claim 76 of the present application recites: A method of approximating an image by decreasing an amount of image data used to create the image, wherein said image data defines a polygonal framework formed of polygons to which textures or pictures are applied, said polygons of said framework being composed of line segments drawn between vertices, said method comprising: (Claim 8 of the Patent recites: *A method of approximating an image by selectively decreasing an amount of image data used to create the image, wherein said image data defines a polygonal framework on which textures or pictures are drawn, said framework being composed of line segments drawn between vertices, said method comprising*); evaluating a degree of importance of each line segment of said framework (claim 8 of the Patent: *assigning an importance value to each line segment of said framework ...* and claim 1 of the Patent: *evaluating a degree of importance of each edge constructing said shape data*); removing an unnecessary line

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segment identified by said step of evaluating a degree of importance of each line segment (claim 8 of the patent: *removing from said framework that line segment having said lowest importance value* and claim 1 of the patent: *removing an unnecessary edge on the basis of a result of an evaluation of said edge*); reconfiguring said framework to account for said removal of said line segment (claim 8 of the Patent: *reconfiguring said framework to account for said removal of said line segment having said lowest importance value*); reconfiguring said textures or pictures applied to said framework to account for said removal of said line segment (claim 14 of the Patent: ... *reconfiguring said textures of pictures drawn on said frame work to account for said removal of said line segment having said lowest importance value*).

The only substantial difference between the presently claimed invention and the cited Patent is *evaluating a degree of importance of each edge*. The edge is well known and widely utilized in the prior art for many years as a line segment. One of ordinary skill in the art at the time the invention was made would have been led in an obvious fashion to provide an edge as a line segment for having a degree of importance of the edge evaluated. This is **a difference in using a term** which fails to patentably distinguish over the prior art absent some novel and unexpected result. Numerous other similar examples in other claims can easily be found.

Furthermore, since the transitional phrase "comprising" does not exclude the presence of elements besides those explicitly claimed, the patented claims already cover the additional limitations disclosed in the patent specification but not claimed. Hence, the patent protection for

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the subject matter claimed in the patent would be extended by the allowance of the claims in the instant application.

Moreover, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 48-75 and 109-136 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-28 of prior U.S. Patent No. 5,963,668. This is a double patenting rejection.

For instance, comparing independent claim 48 of the present application with independent claim 8 of Patent No. 5,963,668:

Claim 48 of the application recites: A method of approximating an image by decreasing an amount of image data used to create the image, wherein said image data defines a polygonal

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framework, said framework being composed of line segments drawn between vertices, said method comprising: (Claim 8 of the Patent recites: *A method of approximating an image by selectively decreasing an amount of image data used to create the image, wherein said image data defines a polygonal framework on which textures or pictures are drawn, said framework being composed of line segments drawn between vertices, said method comprising:*); assigning an importance value to each line segment of said framework (claim 8 of the Patent: *assigning an importance value to each line segment of said framework ...*); removing from said framework that line segment having said lowest importance value (claim 8 of the patent: *removing from said framework that line segment having said lowest importance value*); reconfiguring said framework to account for said removal of said line segment having said lowest importance value (claim 8 of the Patent: *reconfiguring said framework to account for said removal of said line segment having said lowest importance value*).

Another example, comparing claim 109 of the present application with independent claim 15 of the Patent:

Claim 109 of the present application recites: A device for use with a display device that approximates an image by decreasing an amount of image data used to create the image, wherein said image data defines a polygonal framework, said framework being composed of line segments drawn between vertices, said device comprising: (claim 15 of the Patent: *A device for approximating an image by selectively decreasing an amount of image data used to create the image, wherein said image data defines a polygonal framework, said framework being composed*



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*of line segments drawn between vertices, said device comprising:); a memory unit for storing said image data (claim 15 of the Patent: a memory unit for storing said image data); a processor connected to said memory unit, wherein said processor is programmed to: (claim 15 of the Patent: a processor for accessing and processing said image data in said memory unit, wherein said processor:); (a) assign an importance value for each line segment of said framework (Claim 15 of the Patent: assigns an importance value for each line segment of said framework...); remove from said framework that line segment having a lowest importance value (claim 15 of the Patent: removes from said framework that line segment having said lowest importance value); reconfigure said framework to account for said removal of said line segment having said lowest importance value (claim 15 of the Patent: reconfigures said framework to account for said removal of said line segment having said lowest importance value...).*


### **Contact Information**

7. Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4700.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Hong Do whose telephone number is (703) 308-6720.

December 17, 1999.

  
JOSE L. COUSO  
PRIMARY EXAMINER

  
ANH HONG DO  
PATENT EXAMINER